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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,294	02/05/2004	Masaru Izawa	12014-0010DV	3231
22902	7590	04/19/2007		
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			EXAMINER MORILLO, JANEL COMBS	
			ART UNIT	PAPER NUMBER
			1742	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/771,294	Applicant(s) IZAWA ET AL.	
	Examiner Janelle Combs-Morillo	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/5/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 13-15, 19 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 31, 2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8, 9, 12, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Esler (US 3,798,074).

Esler teaches a method for forming a protective surface coating on a steel substrate (abstract, column 5 line 64), said coating comprising: Zn (column 6 line 61), phosphoric acid (column 3 line 45), potassium in the amount of typically 0.2-0.6 mole per ml. (column 3 lines 22-23), which falls within the presently claimed coating composition (cl. 8, 9). Esler does not require fluoride ions for said coating, which meets the limitations of instant claims 12, 16-18. Though does not mention said coating is a 'conversion' coating, because the protective coating taught by Esler has a substantially identical chemical composition, then substantially the same chemical conversion properties are expected to result. Therefore it is held that Esler anticipates the presently claimed process.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossio (US 5,797,987).

Rossio teaches a method for forming a conversion coating on a metal substrate, said conversion coating comprising: Zn, phosphoric acid (column 3 lines 49-53), potassium in the amount of typically 0.4-1.0 g/l (column 4 lines 20, 25-26), and optionally Mn (column 5 lines 38-39, column 12 lines 42-50), which overlaps the presently claimed conversion coating composition (cl. 8, 9). Though Rossio does not specify that said coating is applied to a steel material, it would have been obvious to one of ordinary skill in the art to apply the conversion coating taught by Rossio to a steel substrate, because Rossio teaches said coating is applied to a metal substrate (column 1 line 6), and further teaches that zinc phosphate conversion coatings are generally useful on steel substrates (column 1 lines 13-15).

Concerning claims 10-11, Rossio teaches spray or immersion coating for 0-3 min or 1-5 min at typically 32-71°C (column 7 lines 23-32). However, time and temperature parameters of said coating process are held to be a result effective variable, wherein the coating weight is the expected result.

Changes in concentration or temperature will generally not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such

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concentration or temperature is critical, i.e. they produce a new and unexpected result. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages"). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

6. Claims 8-12, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esler (US 3,798,074) in view of "Metals Handbook Desk Edition" p 1157-1158.

Esler is discussed in paragraphs above. Though Esler does not mention said coating is a 'conversion' coating, because the protective coating taught by Esler has a substantially identical chemical composition, then substantially the same chemical conversion properties are expected to result. Chemical conversion coatings are further discussed in "Metals Handbook Desk Edition", wherein Zn or Mn containing phosphate coatings are sprayed or immersion coated, and activated at temperatures ranging 32-99°C (Table 2, p 1158) and time of >5 min (Fig. 4, p 1158) depending on the coating thickness desired. It would have been obvious to one of ordinary skill in the art to apply the chemical coating taught by Esler over time and temperatures taught by "Metals Handbook Desk Edition" because "Metals Handbook Desk Edition" teaches said parameters are sufficient for providing a given coating weight on a steel substrate.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCM

April 16, 2007

ROY KING
APR 16 2007
FAX 571-273-8300